

REMARKS

Claims 1-18 are pending in the application, of which all claims stand rejected.

Applicant thanks the Examiner for his withdrawal of the claim rejections under 35 U.S.C. 102 and the objection to the disclosure.

Reply to Examiner's "Response to Arguments"

Applicant thanks the Examiner for his consideration of Applicant's arguments and the Declarations filed on April 3, 2006, but Applicant respectfully disagrees with the Examiner's position regarding the relevance of the Tiberia Declaration and the definition of "oak dust" as it relates to the claims. The Examiner asserts that the references to both Strauss and Snodgren show "charred oak dust" as a suitable filler material (*May 24, 2006 Office Action*, page 8, lines 20-22). On the contrary, Strauss discloses only *ground cork* as a filler for a silicone resin. Snodgren discloses only *granulated cork* in a resin composition. While neither reference expressly teaches or suggests the inclusion of oak dust, the Examiner asserts that granulated or ground cork is the same as oak dust. The Examiner further asserts that Applicant has not satisfactorily shown that the "oak dust" in Applicant's claims is the same as the oak dust used in the wine-making industry, nor that this particular oak dust excludes natural cork (*May 24, 2006 Office Action*, page 8, lines 22-24). Applicant again respectfully disagrees with the Examiner. Applicant has presented sufficient evidential support, both in the specification and in the Declarations previously filed that oak dust has a limited meaning that excludes natural cork.

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. MPEP 2173.01. Applicants may define the claimed invention in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. MPEP 2173.01. The Examiner states that a claim term must be interpreted

broadly and not in derogation of its known meaning (*May 24, 2006 Office Action*, page 9, lines 8-9). This is not entirely correct. When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989); see also MPEP 2173.05(a). Furthermore, an Applicant may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings if the written description clearly redefines the terms. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350 (Fed. Cir. 1999); see also MPEP 2173.05 (a).

Applicant's argument regarding the interpretation of oak dust is two-fold. First, the definition of "oak dust" is clearly defined in the specification as being an ingredient that is used in making wine. Second, the ordinary and customary meaning of the term "oak dust" by persons having ordinary skill in the art of wine-making would exclude dust that was made from or included natural cork.

The specification states that "[o]ak dust *is* sometimes used by wineries to enhance the flavor of wine" (*Specification*, paragraph [0025], emphasis added). This statement is a definition. The statement includes the word "is" positioned after the term "oak dust," which signals that the words following "is" will modify and define the term "oak dust." Perhaps the Examiner is lending less weight to this definition of oak dust due to the inclusion of the word "sometimes." It should be noted, however, that the word "sometimes" simply conveys that oak dust, as defined by the specification, is not always included as an additive to enhance the flavor of the wine, but only sometimes. The word "sometimes" does not lend less weight to the definition expressly stated by the Applicant, nor does it suggest that the term has additional meanings that could apply. Instead, the Applicant has used the word "is" to definitively convey

what is meant by the term “oak dust.” The specification, in the same paragraph, further supports the definition of oak dust by informing that oak dust may be obtained from World Cooperage in Lebanon, Missouri. World Cooperage is a barrel and oak alternative supply company that services the wine industry. The oak alternative products sold by World Cooperage are made from French and American oaks. It is clear from the specification that the term “oak dust” is the oak dust that is used by wineries and wine-makers to enhance the flavor of wine.

While the specification is silent on the exclusion of natural cork from the definition of oak dust, Applicant notes that terms are usually defined according to what they are, as opposed to being defined according to what they are not. In the absence of a definition that expressly lists exclusions such as natural cork, the ordinary and customary meaning of the term “oak dust” should be considered. The ordinary and customary meaning of a term should be determined based on the knowledge of a person of ordinary skill in the art. See *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (“the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention”). Here, the person of ordinary skill in the art, based on the usage of the term “oak dust” in the specification, would clearly be a person in the wine-making industry. No other usage of the term “oak dust” can be gleaned from the specification. The term is defined as being an additive to wine, and the company listed as a supplier for the oak dust is a supply company that services the wine industry.

The Declaration of Lawrence Tiberia makes clear that the oak dust used in wine making would never include or be made from natural cork. Mr. Tiberia confirms that oak dust is added to wine during fermentation “to preserve color and add complexity” (Tiberia Declaration, paragraph 4). He goes on to state that oak dust is typically made from white oak trees grown in

the U.S., France, and several eastern European countries (Tiberia Declaration, paragraph 5), and then definitively states that oak dust would never be prepared or manufactured from natural cork (Tiberia Declaration, paragraph 6). Mr. Tiberia states that it is well known in the wine industry that oak dust would not include natural cork (Tiberia Declaration, paragraph 6). He further remarks on the absence of benefits associated with the use of natural cork as an additive to wine, as well as the potential adverse results of adding natural cork to wine (Tiberia Declaration, paragraph 7). Mr. Tiberia's Declaration clearly establishes that oak dust, as viewed by a person of ordinary skill in the art of wine making, would exclude natural cork. In other words, the limitation of "oak dust" as cited in Applicant's claims is not taught or suggested by a prior art reference disclosing a natural cork additive.

The Examiner states that the Tiberia Declaration is "irrelevant since it does not address issues related to the instant claims regarding patentability" (*May 24, 2006 Office Action*, page 9, lines 5-7). As illustrated above, the Tiberia Declaration is directly relevant since it demonstrates what a person of ordinary skill in the art of wine making would view as being the ordinary and customary meaning of oak dust. Specifically, the Declaration illustrates that this skilled person would consider oak dust not to include natural cork. The reason that a skilled person in the wine making industry is relevant to an invention directed to synthetic cork compounds has also been presented above, namely, that the specification defines oak dust as an ingredient that is used by wine makers to flavor wine.

The Examiner further states in his response to Applicant's arguments that "it is not clear to this Examiner why applicants insist that the use of oak dust in the composition claimed would present effects any more or less deleterious to the wine bottled with cork over the conventional cork stopper." (*May 24, 2006 Office Action*, page 9, lines 11-13) The specification clearly

illustrates the advantages of including oak dust in the compound (see for example, *Specification*, paragraph [0025]; “. . . oak dust gives the resulting product a mottled, speckled, or non-uniform appearance that closely resembles natural cork”). The Declaration of Jeannie Holmes, which was also deemed irrelevant by the Examiner, was provided to further emphasize the advantages of including oak dust in the claimed compound (see for example, Holmes Declaration, paragraphs 6 and 7; “. . . gives the resulting product a mottled, speckled, or non-uniform appearance that closely resembles natural cork”; “. . . people that view these stoppers believe that the stoppers more closely resemble natural cork stoppers than other synthetic stoppers currently in use”). These advantages (e.g., providing a compound that closely resembles natural cork) are provided without having the deleterious effects of natural cork, which are also addressed in the specification (see for example, *Specification*, paragraphs [0007]-[0009]; citing degradation, manufacturing difficulties, availability, and tendency of the material to harbor trichloroanisol).

Finally, Applicant disagrees with the Examiner regarding the substance of the interview of March 9, 2006. Based on the interview, it was the understanding of Applicant’s attorney that a statement by a person of ordinary skill in the wine-making industry regarding the definition of “oak dust” would be persuasive to the Examiner in overcoming the rejections that included Strauss and Snogren. Believing this to be the case, Applicant submitted only narrow arguments toward the Strauss and Snogren references and the fact that the references were overcome in light of Applicant’s definition of “oak dust.” While Applicant has re-presented some of these arguments above and outlined for the Examiner what Applicant believes to be sufficient evidence to overcome the outstanding rejections, Applicant submits additional arguments below to traverse the outstanding rejections and preserve these issues for appeal. Applicant respectfully requests consideration by the Examiner of all the arguments submitted herein.

Claim Rejections – 35 USC §103

The Examiner maintained his rejection of Claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Oka et al (WO 03/020817), Merguriya I (U.S. Patent No. 5,981,610), or Meguriya II (U.S. Patent No. 6,506,331), each as applied to the rejected claims under §102, and further in view of Descamps et al (U.S. Patent No. 5,162,397), Strauss (U.S. Patent No. 4,031,059), and Snogren (U.S. Patent No. 3,296,153) all taken together. The Office Action stated:

The reference to Oka et al (WO 03/020817) teaches the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Paragraphs [008] through [0010] show the resin (including claims 2 and 11). The fumed silica is included at paragraph [0011]. The use of cross-linking agents include an organic peroxide (claims 5 and 14) at paragraph [0013] and chloroplatanic acid (claims 4 and 13) at paragraph [0017]. Those citations teach the amounts claimed for each compositional limitation, as embraced by the reference.

The patent to Merguriya et al. (US 5,981,610) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. Note column 2 (lines 19 et seq.) for the resin. Note the paragraph bridging column 3 to column 4 for the use of fumed silica as a known thixotropic agent. Note column 4 (lines 17-22) for the use of chloroplatanic acid, as recited in claim 4. The use of a hollow filler is shown at column 4 (lines 27-48). Further, note the Examples for particular embodiments that embrace the compositional limitations as herein claimed.

The patent to Merguriya (US 6,506,331) teaches the inclusion of the combination of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated as herein claimed. Note column 2 (line 51) to column 3 (line 34) for the resin. Note column 5 (lines 1-16) for the use of fumed silica as a filler. Note column 4 (lines 34-52) for the use of chloroplatanic acid, as recited in claim 4, and (lines 53-64) for the peroxide component. The use of a hollow filler is shown at

column 5 (lines 17-64). Further, note the Examples of particular embodiments that embrace the compositional limitations as herein claimed.

The reference to Oka et al (WO 03/020817), Merguriya et al. (US 5,981,610) and Merguriya (US 6,506,331) each show the broad composition of a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed.

The reference to Oka et al. (WO 03/020817) also teaches the use of pigments at paragraph [0027] and 1-ethynyl-cyclohexanol, used as a curing inhibitor, at paragraph [0028] as recited in instant claims 8, 9, 17 and 18.

The reference to Merguriya et al. (US 5,981,610) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 5, bridging column 8 to column 9. At column 5 (lines 1-16) the reference teaches the use of carbon black, zinc white, known colorants. Both features as recited in instant claims 8, 9, 17 and 18.

The reference to Merguriya (US 6,506,331) teaches the employment of "ethynyl cyclohexanol as a reaction regulator," at Example 1, column 7, and the use of carbon black and zinc white at column 5 (lines 1-16).

The reference to Descamps et al. (US 5,162,397) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 2 (lines 30 et seq.), a cross-linking agent of chloroplatanic acid at column 10 (lines 9 and 10) with a silica filler at column 7 (lines 9-16) and a microsphere agent, including the borosilicates of claims 3, 7-9, 12 and 16-18. Note column 1 (lines 50-66) and column 10 (lines 15-24 and 43-63) for the borosilicates and their compositional inhibitor, such as an acetylenic alcohol (ethynyl cyclohexanol is one) at column 4 (lines 1-25). Carbon black may be included at column 7 (lines 8-16).

The reference to Strauss (US 4,032,059) teaches the manufacture of a composition including a polysiloxane resin, including polydimethylvinylsiloxane at column 13 (line 31) to column 14 (line 12), with hollow microspheres at column 14 (lines 36 et seq.), a curing agent and a silica filler. Note the Examples. The reference teaches the inclusion of ground cork at the paragraph bridging column 4 to column 5 and column 6 (lines 18-26). The

reference is clear as to why ground cork, microspheres and other low density fillers are employed, and deemed essentially equivalent, at column 2 (lines 11-20) and column 4 (lines 59 et seq.) as having a “lower thermal conductivity and higher specific heat.

The reference to Snogren (US 3,296,153) teaches the manufacture of a resin filled composition that may comprise a polysiloxane with a curing agent. The reference further teaches at column 7 (lines 23-66) and Table III, the use of “granulated cork, charred granulated cork” and “small hollow micro spheres,” which may be glass or ceramic materials and may comprise the borosilicates of the instant claims and silica as suitable filler materials. Note the many Examples.

The primary references to Oka et al (WO 03/020817), Merguriya et al (US 5,981,610) and Merguriya (US 6,506,331) all show the broad composition as conventional to include a methyl vinyl silicone polymer, including polydimethylvinylsiloxane, fumed silica, a microsphere constituent and a cross-linking agent, in the compositional limitations as contemplated and herein claimed. The secondary references are relied upon to show the conventionality of each of the various constituents recited in claims 3, 6-9, 12 and 16-18, including the borosilicate microspheres, the toasted oak dust (“charred granulated cork”), pigment, silicon hydride and ethynyl cyclohexanol in silicone resins, including those recited and claimed herein. Since these references represent art analogous in scope, one having an ordinary skill in the art would have a high level of expectation of success. The manipulation of the compositional limitations, depending on availability of materials, anticipated physical characteristics and cost procedures for the manufacture would clearly be within the purview of an artisan skilled in the art. The primary references teach such levels of inclusion. As such, the instant claim would have been obvious to a practitioner in the art in view of the references cited, absent any showing of unexpected results.

Applicant respectfully disagrees that the proposed modification of Oka, Merguriya I, or Meguriya II in view of Descamps, Strauss, and Snogren is obvious, for at least the reasons that (1) the references when combined do not teach or suggest all of the claim limitations, (2) there is no motivation found within the references themselves or knowledge generally available to one

skilled in the art to make the proposed combination, and (3) the Strauss and Snogren references are non-analogous art.

References Do Not Teach or Suggest All of the Claim Limitations

Applicant respectfully submits that the cited references fail to teach or suggest each and every element of the rejected claims. With respect to Claims 1-9, the references, taken together, do not teach or suggest a synthetic cork compound having *oak dust from about 0.1 to 25 weight percent*. With respect to Claims 10-18, the references, taken together, do not teach or suggest a synthetic cork compound having *oak dust of about 1.0 weight percent*. As stated in Applicant's originally-filed specification, the inclusion of oak dust (toasted or untoasted), gives the resulting synthetic cork compound a mottled, speckled, or non-uniform appearance that closely resembles natural cork (see *Specification*, paragraph [0025]). This is important since one of the many possible uses of Applicant's compound is to provide a synthetic alternative to natural cork stoppers in wine bottles. The wine industry has in many cases been slow to adopt synthetic stoppers, and one commonly-stated reason for this is that synthetic stoppers do not closely resemble natural cork stoppers. Hence, the inclusion of oak dust as an ingredient greatly increases the likelihood of acceptance of Applicant's product as a synthetic substitute for natural cork wine stoppers. The effects of oak dust on Applicant's claimed invention are supported by the enclosed Affidavit of Jeannie Holmes.

Natural cork is not equivalent to or suggestive of oak dust.

Both Snogren and Strauss are cited in the Office Action for the teaching of ground cork, granulated cork, or microspheres in a silicone resin. The Office Action states that the inclusion of ground cork teaches or suggests the oak dust component of Applicant's claimed invention.

Applicant respectfully disagrees with this assertion and submits that oak dust is not taught or suggested by the inclusion of ground or granulated cork in a silicone resin.

For the reasons previously stated (see arguments presented above in Reply to Examiner's "Response to Arguments"), it is clear that oak dust as recited in the claims is not taught or suggested by the addition of granulated or ground cork to a silicone resin. Consequently, the Strauss and Snogren references, taken in combination with the other cited references, do not teach or suggest each and every element of the rejected claims.

"Granulated" or "ground" cork does not teach or suggest oak "dust".

Both Snogren and Strauss are cited in the Office Action for the teaching of *ground* cork or *granulated* cork in a silicone resin (emphasis added), and according to the Office Action, these elements teach or suggest the oak dust component of Applicant's claimed invention. Applicant respectfully disagrees with this assertion and submits that neither *granulated* cork nor *ground* cork teaches or suggests oak *dust*. Granulated and ground cork teaches and suggests particle sizes that are larger than dust, and neither reference makes mention of "dust" or "cork dust".

If the Examiner wishes to rely upon an inherency argument to state that oak dust is taught or suggested by Snogren or Strauss, Applicant reminds the Examiner that a rationale or evidence must be provided tending to show inherency. MPEP 2112. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993). The examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. & Inter. 1990). In the instant case, the teachings

of Snogren and Strauss do not absolutely and necessarily teach a dust, therefore the limitation of oak *dust* is not taught or suggested.

No Motivation to Combine the References

The rejection of the Claims 1-18 over Oka, Merguriya I, or Meguriya II in view of Descamps, Strauss, and Snogren is improper because there is no motivation to combine either Strauss or Snogren with the teachings of Oka, Merguriya I, or Merguriya II. The three possible sources for a motivation to combine references are (1) the nature of the problem to be solved, (2) the teachings of the prior art, and (3) the knowledge of persons of ordinary skill in the art. MPEP 2143.01(I). The Examiner presumably relies upon the teachings of the prior art and the knowledge of persons of ordinary skill in the art to combine the references. The Examiner states that “since these references represent art analogous in scope, one having an ordinary skill in the art would have a high level of expectation of success” (*May 24, 2006 Office Action*, page 7, lines 7-8). The Examiner does not point to any particular aspect of the primary or secondary references that would suggest combining the references. Applicant respectfully submits that the references fail to provide any level of suggestion necessary to suggest to a person of ordinary skill the desirability of making the combination. Neither Oka, Merguriya I, nor Meguriya II suggest the desirability of including the ground cork or granulated cork taught by Strauss and Snogren with the silicone compounds of Oka, Merguriya I, and Meguriya II.

The Strauss and Snogren references are also directed at solving different problems than Oka, Merguriya I, and Merguriya II, which further supports Applicant’s position that there is no motivation to combine the references. Oka teaches a silicone compound for gaskets and rollers for copiers, printers, and facsimile machines. Both Merguriya I and Meguriya II teach silicone rubber polymers having relatively low specific gravities. Both Strauss and Snogren teach low-

density ablative materials for protecting re-entry vehicles during high-speed atmospheric travel. The problem to solved by the compounds of Strauss and Snogren is wholly different from those solved by Oka, Merguriya I, and Merguriya II and highlights that there is no teaching or suggestion in the references that would lead a person of ordinary skill in the art to combine them.

Use of nonanalogous art

Applicant further submits that the rejection of Claims 1-18 under §103(a) is improper because the Office Action relies upon nonanalogous art to make the rejection. According to MPEP §2141.01(a), the Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See also In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

The Strauss and Snogren references are not analogous art to the subject matter of Applicant's claimed invention. Both Strauss and Snogren teach low-density ablative materials for protecting re-entry vehicles during high-speed atmospheric travel. The synthetic cork compound of Applicant's invention is aimed at providing a substitute for natural cork. The cork compound eliminates many of the unfavorable characteristics of natural cork, while maintaining many of the favorable characteristics. The low-density ablative materials taught by Strauss and Snogren, on the other hand, are directed to protecting space vehicles during high temperature re-entries into the Earth's atmosphere. Strauss and Snogren are neither in the field of Applicant's endeavor, nor are they reasonably pertinent to the particular problem with which the Applicant was concerned (i.e. providing a substitute for natural cork). Because there is no connection or link between the Applicant's invention and the teachings of Strauss and Snogren, the Strauss and Snogren references are nonanalogous art and should not be used to reject Applicant's claimed invention under §103(a).

Thus, for all of the above-stated reasons, Applicant respectfully submits that the proposed prior art combination of Oka, Merguriya I, or Merguriya II with Snogren and Strauss does not render Claims 1-18 obvious. The references when combined do not teach or suggest all of the claim limitations. There is no motivation found within the references themselves or knowledge generally available to one skilled in the art to make the proposed combination, and the Strauss and Snogren references are non-analogous art relative to Applicant's claimed invention.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of Claims 1-18 under 35 U.S.C. 103(a).

Provisional Double Patenting Rejection

For the reasons stated above with respect to the rejection of the claims under 35 U.S.C. § 103, Claims 1-18 overcome the nonstatutory, provisional, obviousness-type double patenting rejection over Claims 1-16 and 21-41 of copending Application No. 10/685,052 in view of Snogren and Oka.

Applicant respectfully requests that the double patenting rejection be withdrawn.

CONCLUSION

Applicant respectfully submits that the pending Claims 1-18 are in condition for allowance and such a Notice is respectfully requested. The Examiner is invited to call the undersigned at the below-listed telephone number if, in the opinion of the Examiner, such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: _____

10/2/06

RC Hilton

Robert C. Hilton
Reg. No. 47,649
PATTON BOGGS LLP
2001 Ross Avenue
Suite 3000
Dallas, Texas 75201
TEL: 214- 758-6641
FAX: 214-758-1550

ATTORNEYS FOR APPLICANT